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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,493	04/19/2004	John Temple	MMC-10902/29	3298

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EXAMINER

FLANAGAN, BEVERLY MEINDL

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/827,493

Applicant(s)

TEMPLE, JOHN

Examiner

Beverly M. Flanagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

BEVERLY M. FLANAGAN
PRIMARY EXAMINER

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Entry of Amendment

The amendment filed May 17, 2005 has been entered and made of record.

Previously Set Forth Rejections

The 35 U.S.C. § 102(b) rejection of claims 1, 2 and 4 as being anticipated by Morgan et al. (U.S. Patent No. 5,910,106) is hereby *withdrawn*. The 35 U.S.C. § 103(a) rejection of claim 3 as being unpatentable over Morgan et al. (U.S. Patent No. 5,910,106) in view of Beane et al. (U.S. Patent Application Publication No. 2002/0022762) is hereby *withdrawn*.

The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. (U.S. Patent No. 5,910,106) in view of Meckstroth (U.S. Patent No. 5,651,757).

In regard to claims 1, 2 and 4, Morgan et al. teach an instrument heater 21, such as for an optical scope 1, comprised of a sheath 23 having an inner wall 25 and an outer wall 27 where between the inner wall 25 and outer wall 27 is a chemical solution used in forming an exothermic reaction, such as sodium acetate and water (see Figures 1-3 and col. 4, lines 52-55). Between the inner wall 25 and the outer wall 27 at the tip 31 of sheath 23 is an activator disk 41 made from a flexible metal article with a plurality of slits, where flexing of the activator disk 41 released mixture particles of metal and causes a destabilization of the chemical solution to produce heat (see col. 5, lines 5-35 and Figure 3). **With further respect to claim 1**, Morgan et al. are silent as to the sheath 23 being partitioned. However, Meckstroth discloses a similar endoscope warmer 10 comprised of a holster having a plurality of channels 22 through which a heated fluid circulates (see Figure 1). Meckstroth thus demonstrates that an endoscope warmer having partitions for more effectively circulating the warming fluid are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the sheath 23 of Morgan et al. with partitions, in the manner disclosed by Meckstroth, to move effectively circulate the chemical solution.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. (U.S. Patent No. 5,910,106) in view of Meckstroth (U.S. Patent No. 5,652,757), and further in view of Beane et al. (U.S. Patent Application Publication No. 2002/0022762).

In regard to claim 3, Morgan et al. are silent as to a housing to contain the sheath 23. However, Beane et al. disclose a similar warming device for an endoscope

10 where the device 110 has a housing 112 that contains a heating pad 120 into which the endoscope 10 is inserted (see Figure 2A). Beane et al. thus demonstrate that housing for containing a device to heat the insertion tube of an endoscope are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the instrument heater 21 of Morgan et al. with a housing to contain the sheath 23.

Response to Arguments

Applicant's arguments filed with the amendment of May 17, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the device of Meckstroth, which is also a surgical instrument warmer, incorporates partitions for circulating fluid (see Figure 1). Thus, the prior art suggests utilizing partitions for circulating fluid. The fact that Morgan et al. do not teach partitions does not negate the fact that the prior art recognizes partitions for circulating fluid and thus provides a motivations for applying such partitions to the device of Morgan et al. Furthermore, one

cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

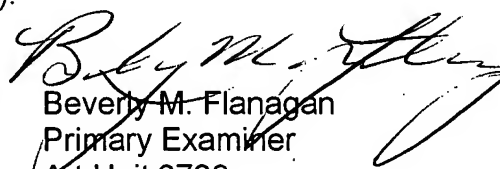
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (571) 272-4766. The examiner can normally be reached on Mondays, Tuesdays and Thursdays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Beverly M. Flanagan
Primary Examiner
Art Unit 3739
